

Remarks

This Application has been carefully reviewed in light of the Office Action mailed February 17, 2006. Although Applicant believes all claims are allowable without amendment, to advance prosecution Applicant has made amendments to Claims 1, 4, 9, 12, 17, 20, 28, 31, and 36. At least certain of these amendments are not considered necessary for patentability. Applicants have also amended Claim 24 to correct a typographical error. Dependent Claims 2, 12, 19, and 30 have been canceled without prejudice or disclaimer. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. Information Disclosure Statement (IDS)

Applicant appreciates the Examiner's consideration of the references cited in the IDS filed on November 18, 2005.

II. Claims 5, 13, and 32 are Definite without Amendment

The Examiner rejects Claims 5, 13, and 32 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully disagrees.

In particular, the Examiner states, "Claims 5, 13, and 32 recite 'it is' [in] line 2 respectively. Pronouns are not permitted, only what is being referred [to] by 'it' should be set forth in the claim. Applicants are advised to amend the claim[s] so [as to] solve the 112 rejection set forth in the claim." (Office Action, Page 2)

First, Applicant notes that the Examiner has not provided any citation (e.g., to applicable statutes, case law, regulations, or rules) to support the Examiner's statement that "[p]ronouns are not permitted, only what is being referred [to] by 'it' should be set forth in the claim." Applicant is not aware of any *per se* rule prohibiting the use of pronouns in claims. In fact, the M.P.E.P. states, "Office policy is not to employ *per se* rules to make technical rejections. Examples of claim language which have been held to be indefinite set forth in MPEP § 2173.05(d) are fact specific and should not be applied as *per se* rules." M.P.E.P. § 2173.02 (emphasis in original)

Second, the essential inquiry pertaining to the definiteness requirement is whether the claims set out and circumscribe subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing ordinary skill in the art at the time the invention was made. M.P.E.P. § 2173.02. Furthermore, the test for indefiniteness under Section 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” M.P.E.P. §2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)).

Applicant respectfully submits that those of ordinary skill in the art would understand Claims 5, 13, and 32 in their present form. In particular, Applicant respectfully submits that those of ordinary skill in the art would understand to what the phrase “it is” in Claims 5, 13, and 32 refers. For example, independent Claim 1 recites the limitation:

applying a condition test to each filter item of the filter, the condition test comprising:

determining if the filter item comprises a NOT connective; and
determining if the filter item comprises one of a type only filter item or a type and value filter item.

Dependent Claim 5 recites “if it is determined that the filter item comprises a NOT connective and a type and value filter item,” performing the limitations recited in the remainder of Claim 5. Clearly, the phrase “if it is determined” in Claim 5 refers to the determinations recited in Claim 1. In fact, Applicants believe that using the phrase “it is” actually provides more clarity than if the substance of the two determinations were recited again in full in dependent Claim 5, which would make the claim more burdensome to read and understand. The use of the phrase “it is” in Claims 13 and 32 is similarly clear.

Third, the M.P.E.P provides, “[I]f the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph [which, as discussed above, Applicant believes it does], but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112,

second paragraph, rather, the examiner should suggest improved language to the applicant.” M.P.E.P. § 2173.02. If the rejection under 35 U.S.C. § 112, second paragraph, was the only issue remaining in the Application, Applicant would consider amending Claims 5, 13, and 32 according to a suggestion from the Examiner. However, given that the Examiner has not provided such a suggestion and, as discussed above, Applicant believes that these claims are definite as written, Applicant has not made such amendments in this Response.

For at least these reasons, Applicant respectfully submits that Claims 5, 13, and 32 comply with 35 U.S.C. § 112, second paragraph. Thus, Applicant respectfully requests reconsideration and allowance of Claims 5, 13, and 32.

III. The Claims Are Allowable Over the Examiner’s Proposed Combination of the Description of Related Art and Corn

The Examiner rejects Claims 1, 3-9, 11-17, 19-22, 24-28, and 30-36 under 35 U.S.C. 103(a) as being unpatentable over Applicant’s alleged “admitted related art,” citing the section of Applicant’s Specification entitled “Description of Related Art” (the “*Description of Related Art*”),¹ in combination with U.S. Patent 6,356,892 to Corn, et al. (“Corn”). (See Office Action, Page 2) Applicants respectfully disagree.

A. The *Description of Related Art-Corn* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant’s Claims

Applicant respectfully submits that the Examiner’s *Description of Related Art-Corn* combination does not disclose, teach, or suggest various limitations recited in Applicant’s claims. Applicant discusses independent Claim 1 as an example.

For example, the *Description of Related Art* fails to disclose, teach, or suggest at least the following limitations recited in Claim 1 as amended:

- applying a condition test to each filter item of the filter, the condition test comprising:

¹ Applicant again reiterates that the *Description of Related Art* sets forth background and related information with respect to Applicant’s disclosure. Applicant has made no express or implied admission that the description included in the *Description of Related Art* qualifies as “prior art.” Thus, Applicant maintains that the *Description of Related Art* does not provide a proper basis for rejecting Applicant’s claims.

- determining if the filter item comprises a NOT connective; and
- determining if the filter item comprises one of a type only filter item or a type and value filter item; and
- if it is determined that the filter item comprises a NOT connective and a type only filter item, applying a logical methodology to evaluate the NOT connective, the logical methodology comprising expanding an expression of the filter item so that the filter item does not comprise the NOT connective.

First, the Examiner acknowledges that the *Description of Related Art* does not disclose “applying a condition test to each filter item of [a] filter, the condition test comprising determining if the filter item comprises a NOT connective . . . and determining if the filter item comprises one of a type only filter item or a type and value filter item,” as recited in Claim 1. However, the Examiner argues that *Corn* discloses these limitations. Applicant respectfully disagrees. There is simply no disclosure, teaching, or suggestion in the portions of *Corn* cited by the Examiner of applying a condition test to each filter item of a filter, the condition test comprising explicitly making both of the following determinations: (1) determining if the filter item comprises a NOT connective; and (2) determining if the filter item comprises one of a type only filter item or a type and value filter item. In particular, nowhere does *Corn* disclose, teach, or suggest explicitly “determining if the filter item comprises one of a type only filter item or a type and value filter item,” as recited in Claim 1.

At best, the cited portions of *Corn* appear to disclose determining whether certain filter elements include particular statements (e.g., a simple equality statement) or expressions (e.g., a greater than or equal expression). (See, e.g., *Corn*, 8:52-66) However, nowhere do the cited portions of *Corn* appear to disclose, teach, or suggest determining if the filter item comprises one two classes of filter items: a type only filter item or a type and value filter item.

Even more clearly, nowhere does *Corn* disclose, teach or suggest “if it is determined that the filter item comprises a NOT connective and a type only filter item, applying a logical methodology to evaluate the NOT connective, the logical methodology comprising

expanding an expression of the filter item so that the filter item does not comprise the NOT connective,” as recited in Claim 1 as amended.

For at least these reasons, Applicant respectfully submits that the proposed combination fails to disclose, teach, or suggest each and every limitation recited in Claim 1. For at least certain analogous reasons, Applicant respectfully submits that the proposed combination fails to disclose, teach, or suggest each and every limitation recited in Claims 9, 17, 28, and 36, and their dependent claims.

B. The Examiner’s Proposed Combination of the *Description of Related Art* and *Corn* is Improper

Applicant respectfully submits that the Examiner has not shown the requisite teaching, suggestion, or motivation in either the *Description of Related Art* or *Corn*, or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant’s invention, to combine or modify the *Description of Related Art* with *Corn* in the manner proposed by the Examiner. Applicant’s claims are allowable for at least this additional reason.

1. The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the references taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the references why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Description of Related Art-Corn* combination does not, taken as a whole, suggest the claimed invention, taken as a whole.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention.” M.P.E.P. § 2143.01 (emphasis added). Even the fact that references can be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.² According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the

² Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

“range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* *Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”* *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). See also *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (*holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine*); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. See *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “*The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*” M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based

on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also,* e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembicza*k, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. Analysis

With respect to the proposed *Description of Related Art-Corn* combination, the Examiner acknowledges that the *Description of Related Art* does not disclose certain limitations recited in Applicant's independent claims, asserts that *Corn* discloses these limitations, and states the following:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the filter expansion of the query service, as disclosed by the applicant's admitted prior art would incorporate the use of applying a test condition to each filter item by determining if the filter comprises a NOT connective and comprises one of a type only filter item or a type and value filter item. One having ordinary skill in the art would have found it motivated to use such a combination for the purpose of providing better performance results.

(*See, e.g.*, Office Action, Page 3)

Thus, the purported motivation for combining the *Description of Related Art* with *Corn* that is provided by the Examiner is “for the purpose of providing better performance results.” First, Applicant’s respectfully submit that the Examiner has not provided any support for this purported motivation. In other words, the Examiner has not shown the requisite teaching, suggestion, or motivation in either the *Description of Related Art* or *Corn*, or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant’s invention, to combine or modify the *Description of Related Art* with *Corn* in the manner proposed by the Examiner. The Examiner’s statement does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to modify the particular techniques disclosed in the *Description of Related Art* with the cited disclosure in *Corn*; (2) how one of ordinary skill in the art at the time of Applicant’s invention would have done so; or (3) how doing so would purportedly meet the limitations of Applicant’s claims.

Even assuming that either the *Description of Related Art* or *Corn* did disclose, teach, or suggest “providing better performance results” and that the *Description of Related Art* and *Corn* disclosed the limitations recited in Applicant’s claims as alleged by the Examiner, the Examiner still has not shown, in either cited reference or in the knowledge of ordinary skill in the art at the time of Applicant’s invention, why one of ordinary skill in the art at the time of Applicant’s invention would have been motivated to combine the alleged teachings from the *Description of Related Art* with the alleged teachings of *Corn* in order to “provide better performance results.” The Examiner certainly has not identified any portion of either reference that suggests that this combination would achieve such a result (i.e., would provide better performance results). Applicant respectfully submits that it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the particular techniques disclosed in the *Description of Related Art* with the cited disclosures in *Corn* in the manner proposed by the Examiner.³ Applicant respectfully submits that the Examiner’s attempt to modify or combine these

³ If “common knowledge” or “well known” art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

references appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the references fail to provide the required teaching, suggestion, or motivation to combine the *Description of Related Art* with *Corn* in the manner the Examiner proposes, Applicant respectfully submit that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

C. Conclusion with Respect to the Obviousness Rejections

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 9, 17, 28, and 36 and their dependent claims

III. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion

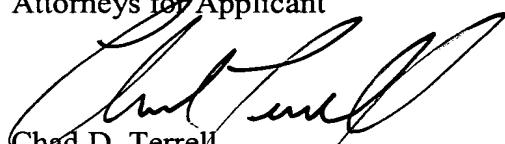
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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